

24. (Amended) A film for use in an optical system comprising a light source and a polarizer having a polarization axis, the film comprising a transparent material including a first surface and a second surface, said first surface having a structure including a plurality of isosceles triangular prisms arranged side-by-side for increasing luminance of light passing through said film in a direction corresponding to said polarization axis of said polarizer, and said second surface having an optically rough structure for diffuse transmitting light emitted by said light source, wherein a top angle of said isosceles triangle prisms is in a range of about 90 degrees to about 120 degrees, wherein the tops of the isosceles triangle prisms are no more than 160  $\mu$ m apart.

#### REMARKS

The above amendment is made in response to the Office Action of May 5, 2000. The Examiner's reconsideration of the rejections is respectfully requested in view of the foregoing amendments and the following remarks.

Applicant will surrender the original patent upon indication that the new reissue claims include patentable subject matter. Applicant respectfully requests that the surrender of the original patent be held in abeyance until such indication is received.

Claims 8 to 42 were rejected under 35 U.S.C. §112, first paragraph. The Examiner stated, "the pending claims deleted the 'arranged side-by-side' limitation. By doing so, applicants are claiming subject matter which was not disclosed in the specification as originally filed, since all the embodiments, examples and figures disclosed the prisms arranged in a side-by-side manner. The new matter being the prisms arranged in something other than a side-by-side manner. Applicant has not disclosed in the originally filed specification 'a variation in

itches between the tops of adjacent isosceles triangle prisms.' Again this limitation constitutes new matter."

Applicant respectfully disagrees that by removal of "arranged side-by-side" limitation from the claims, the claims are limited to prisms arranged in something other than a side-by-side manner. Applicants believe that a claim without the "arranged side-by-side" limitation can be interpreted to mean any prism arrangement including a side-by-side manner. In any event, applicant has reinserted the "arranged side-by-side" limitation in each of the independent reissue claims.

Regarding the claim limitation "a variation in pitches between the tops of adjacent isosceles triangle prisms," applicant respectfully submits that such feature was originally disclosed in the priority document, JP 4-246225 in Figure 5, wherein it was indicated that "pitch equals  $150 \pm 10 \mu\text{m}$ ." The "minus" sign beneath the "plus" sign was inadvertently omitted at the time of filing of the application leading to the '462 patent. Such omission was corrected in the proposed corrected Figure 5 submitted in the Supplemental Amendment of November 30, 1999. With the correction, it is believed that Figure 5 supports the feature of "variation in pitches" namely  $\pm 10 \mu\text{m}$ , between the tops of adjacent isosceles triangle prisms.

Reconsideration of the rejection is respectfully requested.

Claims 8, 9 and 11 to 42 were rejected under 35 U.S.C. §251 as improperly broadened in a reissue application. The Examiner stated, in part, "the claims are the same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejections... [they] are not used to solve an error within the meaning of 35 U.S.C. §251... applicants argued the criticality of the viewing angles and correlated the viewing angles to

the top prism angle of 95 degrees to 120 degrees to the viewing angles and then proceeded to delete all limitations having 90 degree to 120 degree range.”

Again, applicant respectfully disagrees with the Examiner’s analysis of the recapture rule.

The recapture rule is applicable to “prevent a patentee from regaining through reissue...subject matter that he surrendered in an effort to obtain allowance of the original claims.” In re Clement, 131 F. 3<sup>rd</sup> at 1368, 45 USPQ 2<sup>nd</sup> at 1164. The central question in this reissue application is what subject matter did the applicant surrender to obtain allowance of the original claims? In paper no. 16, applicants argued numerous features of the invention which distinguish from the Kashima reference including, “viewing angle defined as at least +/- 35 degrees in the vertical direction and +/- 55 degrees in the horizontal direction” (page 4 of remarks in paper no. 16), “the film having an optically rough bottom face to first diffuse the light and a second smooth angled top face to concentrate the diffused light into the conical space defined by the vertical and horizontal viewing angles.” The Examiner also pointed to applicant’s remarks, “improvements in the viewing light occur when the tops of the prisms are spaced at regular intervals not exceeding 160  $\mu\text{m}$  to prevent visible interference fringes and are aligned with a polarizing axis of the polarizer to decreased light loss” (pages 4 and 5 of remarks).

It is clear from the record that not all the features argued in the remarks in paper no. 16 became limitations in the independent claims of the ‘462 patent. For example, the feature of “viewing angle of +/- 35 degrees in a vertical direction and +/- 55 degrees in a horizontal direction” did not appear in any claim in the ‘462 patent. The feature of “the tops of the isosceles triangle prisms are not further than 160  $\mu\text{m}$  apart” became part of claims 2, 5, and 7. Such feature did not appear in any independent claims in the ‘462 patent. Thus, the Examiner believed

that these features were not needed to distinguish from Kashima to obtain allowance of the main claims.

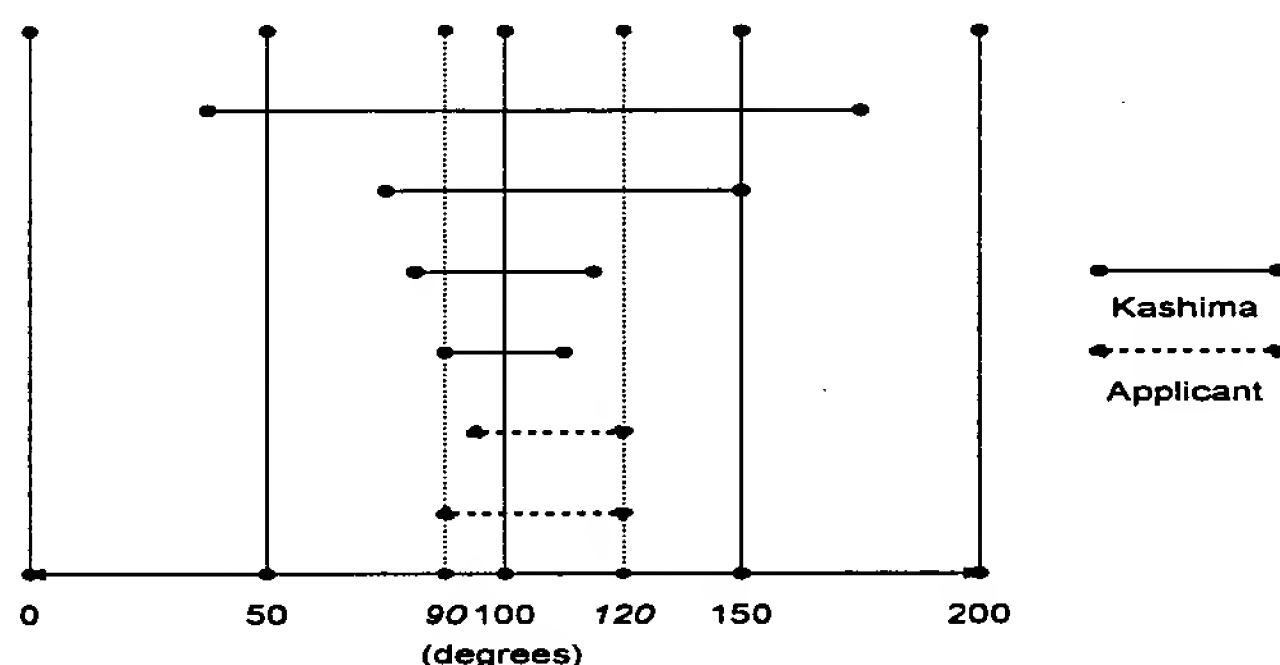
With respect to the claim clause, "wherein a top angle of said isosceles triangle prisms is in a range of 95 degrees to 120 degrees for flat, angle prism surfaces to gather light from the diffused transmission into a desired viewing angle for the liquid crystal display panel," which does appear in the main claims 1, 3 and 6 of the '462 patent, applicant respectfully submits that the "95 degrees to 120 degrees" within the claim clause is not the feature critical in distinguishing from Kashima for at least two reasons.

First, the Examiner may recall that the change from 90-120 degrees to 95-120 degrees was first made in paper no. 8, when applicant was not faced with a rejection based on the range of top angles. (See pages 5 and 6 of Amendment dated 10/29/99). The 95-120 degrees top angle was later added to then claim 5, which issued as claim 1 in the '412 patent.

Second, the top angle range was not the critical aspect which distinguished from Kashima because it can be seen from applicant's remarks in paper no. 16, "the Kashima et al. patent mentions three ranges of angles. The language in the Kashima et al. patent is confusing. It is not clear what angle is being described as being within the specified ranges. The angle as claimed in claim 6 as being an "apical" angle being formed in connection with some vertical cut made through the apex of the projections when a cut is made to obtain a minimum apical angle. What is clear is that it is not the angle made by the intersection of flat, angled surfaces. The exit face of the Kashima et al. patent is described as being convex and concave and is presented as curved in Figure 6. It is not made up of flat, angled surfaces like the sides of the prisms or pyramids"(pages 5 and 6 of remarks in paper no. 16).

Thus, in paper no. 16, applicant distinguished the invention from Kashima based on "forming of the isosceles triangle prisms for flat angled prism surfaces to gather light from the

diffused transmission into a desired viewing angle.” The range of top angle was not and could not have been the distinguishing feature. To further illustrate, Kashima disclosed top angles as shown:

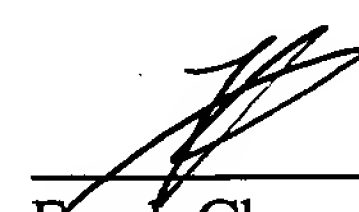


Kashima disclosed: a first range between 40 to 170 degrees, a second range between 80 to 150 degrees, a third range between 85 to 120 degrees, and a range between 90 to 110 degrees. Applicant's top angle, whether from 95 degrees to 120 degrees or from 90 degrees to 120 degrees, would have been within the range taught in Kashima. Thus, whether applicant's top angle was from 95 to 120 degrees, or from 90 to 120 degrees, the specific top angle was not the feature which distinguished from Kashima and therefore the specific top angle could not have been the basis for allowance of the application leading to the '462 patent. It then follows that, whether the top angle was from 95 degrees to 120 degrees or from 90 degrees to 120 degrees was not subject matter surrendered during prosecution of the '462 patent. Accordingly, the recapture rule does not prevent the applicant from claiming in the present reissue application what he rightfully could have claimed during the prosecution of the '462 patent. The Examiner's reconsideration of his rejections is respectfully requested.

For the foregoing reasons, claims 8, 9, 11 to 13, 15 to 20, 22 to 24, 26, 28, 29, 31, 32, 35 to 38, 40 and 41 of the application are believed allowable for reissue. The Examiner's early and favorable action is respectfully urged. Should the Examiner believe that a telephone or personal interview may facilitate resolution of any remaining matters, it is requested that the Examiner contact Applicant's undersigned attorney.

Respectfully submitted,

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